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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,841	08/02/2001	Alain Rambach	1567P368	8188

7590 07/13/2004

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EXAMINER	
MARX, IRENE	

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,841	RAMBACH ET AL.	
	Examiner	Art Unit	
	Irene Marx	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 25-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 25-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The application should be reviewed for errors. Error occurs, for example in the spelling of "ammoniacacal" in claim 25.

The amendment filed 6/30/04 is acknowledged. Claims 1-9 and 25-27 are being considered on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 25-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No basis or support is found in the present specification for the recitation of "indoxyl chemical derivative".

Also, no basis or support is found in the present specification for the now inserted full chemical names in claim 4. There is no clear nexus between the abbreviations used and the chemical names provided in the instant specification. It is noted, for example that the compounds are denoted as "indolyl" rather than "indoxyl" as argued.

Therefore, this material raises the issues of new matter and should be deleted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 25 are vague, indefinite and confusing in the recitation "indoxyl chemical derivative", since the derivatives intended are not defined in the instant specification. See also the new matter rejection *supra.*

Claim 6 is vague and indefinite in the recitation of "aerobic anaerobic bacteria". It is unclear what is intended. Applicant argues that this is a term of art. However, no evidence in this regard was provided. The term in general usage in the art for the material argued is "facultative".

Claims 25 and 26 are vague and indefinite in that the ingredients of the composition intended cannot be readily determined. While product by process claims are proper, the claim as written depends on a product claim and process steps are included under "further comprising", including a process of culturing bacteria. In addition, the phrase "wherein the bacteria contains one of an appearance of a colored precipitate around the colonies, a color of the colonies, and both an appearance of a colored precipitate around the colonies and a color of the colonies" is not understood. It is unclear how bacteria are to "contain" "an appearance of a colored precipitate around the colonies" in a composition claim. Similarly, it is unclear how the bacteria are to "contain" "a color of the colonies" in a composition claim. Applicant is reminded that the claims are drawn to a bacterial culture medium.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sellers for the reasons as stated in the last Office action and the further reasons below..

The present application relates to a bacteria culture medium including a metal complex enabling the oxidative polymerization of an indoxyl derivative and a substrate containing an indoxyl derivative, leading to an insoluble colored compound.

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant argues that the Sellers reference is inappropriate since it directed to indole rather than "indoxyl". This argument is irrelevant to the claims of record, which are directed to an "indoxyl chemical derivatives" rather than "indoxyl". While applicant has not presented objective evidence to substantiate the alleged structure of "indoxyl", indole is, in fact, a "chemical derivative of indoxyl". To confuse the issue further, the specific compounds of claim 4, are now recited as being "indolyl" rather than "indoxyl" compounds. The distinction is unclear on this record. Furthermore, it must also be considered that the terminology "indoxyl chemical derivative", in fact, constitutes broad terminology, since virtually any compound may be considered a "chemical derivative" when the distance in derivation is not delineated with any particularity, as is the case herein.

The mechanism of the reaction is not an element of the invention as claimed. All that is claimed is a bacterial culture medium comprising at least one metal complex that has the functional limitation of "allowing" oxidative polymerization of an "indoxyl chemical derivative" and a substrate containing an "indoxyl chemical derivative" to result in an insoluble colored compound.

The arguments fail to be persuasive of error in the rejection. Therefore the rejection is deemed proper and it is adhered to.

Claims 1-9 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sellers taken with Chevalier *et al.* and Difco Manual for the reasons as stated in the last Office action and the further reasons below.

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

The Sellers reference is discussed above. Regarding Chevalier and Difco, these references are cited to demonstrate that magnesium sulfate in combination with chromogenic substrates for the detection of α-galactosidase are known in the art (See, e.g., Chevalier, page 77, Difco Manual, pages 246-247). Moreover, Chevalier *et al.* is cited for the disclosure that the use of antibiotics in selective media is a well known technique in the art (See, e.g., page 76, paragraph 1). In addition, the use of cysteinated Columbia medium is old and well known in the art, as adequately demonstrated by Difco Manual (See, e.g., pages 125-126).

With all due respect, there is no limitation in claim 1 requiring "ferric" as argued (Response, page 7, penultimate paragraph). The only claim that requires iron is claim 3, which requires "ammoniacal iron citrate". As noted *supra,* the limitations of this claim as written cannot be determined with any specificity. Therefore, this argument lacks merit.

Therefore the rejection is deemed proper and it is adhered to.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irene Marx
Primary Examiner
Art Unit 1651